

Application No. 09/729,118

RD-27953-1

RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 1639

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

James N. Cawse

Serial No. 09/729,118

: Group Art Unit: 1639

Filed: December 4, 2000

: Examiner: J.D. Epperson

For PERMEABLE REACTOR PLATE AND METHOD

**MPEP 706.07(e) AND MPEP 706.07(d) REQUEST TO WITHDRAW FINAL
REJECTION**

OFFICIAL

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Primary Examiner is requested to withdraw the March 23, 2004 Final Rejection for the following reasons:

1. Claims 1 to 7, 10, 16 and 37 to 40 are pending.
2. The March 23, 2004 Final Rejection rejected claims 1 to 7, 10, 16 and 37 to 39 under 35 U.S.C. §103(a), claim 50 under 35 U.S.C. 112, first paragraph and claims 1 to 7, 10 and 37 under 35 U.S.C. §102.
3. The March 23, 2004 Final Rejection is a premature final rejection.

I. FAILURE TO POINT OUT WHERE TEACHINGS APPEAR IN THE REFERENCES

4. MPEP 2271 states:

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.... The grounds of rejection must (in the final rejection) be clearly developed to such an extent that the patent owner may readily judge the advisability of an appeal....

5. 37 C.F.R. § 1.104 entitled "Nature of Examination" provides that "[t]he examiner's action will be complete as to all matters...."

6. The Final Rejection fails to point out where the following claim limitations appear in the references to support its 35 U.S.C. §103(a) and 35 U.S.C. §102 rejections:

(1) a "permeable polycarbonate film sealed to cover at least one cell" that "selectively permit(s) transport of a reactant gas comprising oxygen and carbon monoxide into the at least one cell while preventing transport of a diaryl carbonate reaction product out of the at least one cell" (claims 1 to 7, 10, 16 and 37 to 38); (2) a diffusion coefficient of "5 X 10⁻¹⁰ to 5 X 10⁻⁷ cc(STP)-mm/cm²-sec-cmHg" (claim 2), (3) a diffusion coefficient of "1 X 10⁻⁹ to 1 X 10⁻⁷ cc(STP)-mm/cm²-sec-cmHg" (claim 3); (4) coefficient of "2 X 10⁻⁸ to 2 X 10⁻⁶ cc(STP)-mm/cm²-sec-cmHg." (claim 4) or (5) two opposing walls comprising sealed permeable polycarbonate film" (claim 37).

7. The 35 U.S.C. §103(a) rejection of the Final Rejection is based on a combination of references but the Final Rejection fails to point out in the references, the required *In re Lee* reasoning to combine.

II. INCORRECT EXAMINATION STANDARD

8. The March 23, 2003 Final Rejection states "Applicant's arguments filed May 30, 2003 have been fully considered but they are not persuasive for the reasons of record and the following comments."

9. However, 35 U.S.C. 103(a) rejections are based on 35 U.S.C. 102(a) stating "A person shall be entitled to a patent *unless* (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent..." (emphasis added).

10. A patent must be issued unless the PTO establishes a reason not to issue

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the patent.

11. Further, MPEP 2142 points out that:

.... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

MPEP 2142.

12. Whether "Applicant's argument has been found to be unpersuasive" is an incorrect standard of examination where the issue is whether the PTO has met its burden of establishing a *prima facie* case of obviousness.

13. The Final Rejection applies an incorrect examination standard by requiring Applicant to overcome rejection without the PTO first meeting its burden of establishing unpatentability.

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III. CONCLUSION

14. The Final Rejection fails to point out in the references, the (1) to (5) teachings to establish a *prima facie* case of obviousness or anticipation, fails to point out in the references, the required *In re Lee* reasoning to combine and the Final Rejection applies an incorrect standard of examination.

15. This Request to Withdraw the Final Rejection is filed pursuant to MPEP 706.07(c) and MPEP 706.07(d) as prerequisite to Petition to the Commissioner of Patents.

16. Applicants respectfully request the PTO to withdraw the Final Rejection and to allow the claims or issue another non final office action to address in the references, teachings (1) to (5), to address in the references, the *In re Lee* reasoning to combine and to apply a correct standard of examination.

Respectfully submitted,



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